

ESTTA Tracking number: **ESTTA704981**

Filing date: **10/28/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Astucci U.S. Ltd.
Granted to Date of previous extension	10/28/2015
Address	385 Fifth Avenue New York, NY 10016 UNITED STATES
Correspondence information	David B. Sunshine Cozen O'Connor 277 Park Avenue New York, NY 10172 UNITED STATES tmdocketing@cozen.com, dsunshine@cozen.com Phone:2128834900

Applicant Information

Application No	79154399	Publication date	06/30/2015
Opposition Filing Date	10/28/2015	Opposition Period Ends	10/28/2015
International Registration No.	1221647	International Registration Date	06/24/2014
Applicant	GATTO ASTUCCI S.p.A. Via Gei, 12 ITALY		


Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Spectacle cases
Class 020. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Display units, namely, display cases, point of purchase and point of sale displays, cabinets, display racks, display stands
Class 021. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Articles for cleaning purposes, namely, cleaning cloths, cloths for cleaning spectacles and high tech displays

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2627183	Application Date	01/12/2000
Registration Date	10/01/2002	Foreign Priority Date	NONE
Word Mark	ASTUCCI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1994/06/10 First Use In Commerce: 1994/08/01 EYEGLOSS CASES Class 018. First use: First Use: 1994/06/10 First Use In Commerce: 1994/08/01 HANDBAGS		

Attachments	75909514#TMSN.png(bytes) Astucci Notice of Opp Final.pdf(162882 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David B. Sunshine/
Name	David B. Sunshine
Date	10/28/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 79/154,399
For the Mark: GATTO ASTUCCI 1937 and Design
Published in the *Official Gazette* on June 30, 2015

ASTUCCI U.S. LTD.,

Opposer,

v.

GATTO ASTUCCI S.P.A.,

Applicant.

Opposition No.: _____

NOTICE OF OPPOSITION

Astucci U.S. Ltd. (hereinafter “Astucci” or “Opposer”), a New York corporation, having its principal place of business at 385 Fifth Avenue, New York, New York 10016 believes it will be damaged by registration of the mark GATTO ASTUCCI 1937 and Design (“Applicant’s Mark”) which mark is the subject of Application Serial No. 79/154,399 filed June 24, 2014 in the name of Gatto Astucci S.p.A. (“Gatto Astucci” or “Applicant”), located at Via Gei, 12 I-32040 Domegge Di Cadore (BL) Italy and hereby opposes the same.

The grounds for opposition are as follows:

1. On or about June 24, 2014, Applicant filed a trademark application in the United States Patent and Trademark Office (“USPTO”) for the mark GATTO ASTUCCI 1937 and Design. A representation of the mark is as follows:



The application was assigned Application Serial No. 79/154,399 (hereinafter, the “‘399 Application”).

2. Upon information and belief, the ‘399 Application is based on Section 66(a) of the Trademark Act for the purpose of extending protection of an international trademark registration to the United States and purportedly with an intent to use the GATTO ASTUCCI 1937 and Design mark in commerce. Applicant’s claimed priority date is June 18, 2014.

3. The ‘399 Application identifies “spectacle cases” in International Class 9, “display units, namely, display cases, point of purchase and point of sale displays, cabinets, display racks, display stands” in International Class 20 and “articles for cleaning purposes, namely, cleaning cloths, cloths for cleaning spectacles and high tech displays” in International Class 21 (hereinafter “Applicant’s Goods”).

4. The ‘399 Application was published for opposition in the *Official Gazette* of the USPTO dated June 30, 2015.

5. Opposer has been granted an extension of time by the Trademark Trial and Appeal Board to file a Notice of Opposition against the ‘399 Application, to and including October 28, 2015.

6. Since long prior to the filing and/or priority date of the ‘399 Application and prior to the first use, if any, of Applicant’s Mark, Opposer has continuously used in commerce the trademark ASTUCCI for eyeglass cases and handbags, among other products. As a result, priority of use belongs to Opposer.

7. Opposer is the owner of U.S. Trademark Registration No. 2,627,183 for the mark ASTUCCI which was registered on October 1, 2002 (hereinafter, the “‘183 Registration”). The ‘813 Registration is incontestable pursuant to 15 U.S.C. 1065. The ‘813 Registration is attached as Exhibit 1.

8. The '183 Registration identifies "eyeglass cases" in International Class 9 and "handbags" in International Class 18 (hereinafter "Opposer's Goods").

9. Opposer has adopted and used for many years in interstate commerce and is and has been at all times pertinent hereto (including since long prior to the filing date of the '399 Application), the owner of all right, title and interest in and to the mark ASTUCCI in connection with Opposer's Goods as well as related goods.

10. As a result of the long, widespread and extensive use, advertising and promotion by Opposer of Opposer's ASTUCCI mark, Opposer's ASTUCCI mark serves to identify and distinguish Opposer's Goods from the goods, services and businesses of others and has come to symbolize the goodwill of Opposer's business. Opposer has invested a great deal of money and effort in promoting Opposer's Goods sold under the ASTUCCI mark and Opposer is continuing to spend substantial amounts of money in promoting such goods.

11. Upon information and belief, Applicant is unable to establish, with respect to Opposer's use of Opposer's ASTUCCI mark, priority of use or priority of rights in the United States in connection with Applicant's Mark.

12. Applicant's Goods and Opposer's Goods both include eyeglass cases and products related to eyeglass cases including the sale and marketing of eyeglass cases. In addition, upon information and belief, Applicant's Goods and Opposer's Goods are offered or may be offered through the same, substantially the same, and/or related channels of trade, to the same, substantially the same, and/or related classes of purchasers, and are or may be advertised, marketed and promoted through the same media channels.

13. Upon information and belief, Applicant's Mark, when used in connection with Applicant's Goods, so resembles Opposer's ASTUCCI mark as to be likely to cause confusion, or to cause mistake, or to deceive with respect to the source or origin of Applicant's Goods, with

respect to Opposer's sponsorship thereof or connection or affiliation therewith, and/or in other ways.

14. Opposer would be damaged by registration of Applicant's Mark because such registration would constitute *prima facie* evidence of Applicant's exclusive right to use Applicant's Mark connection with Applicant's Goods, which would be inconsistent with and detrimental to Opposer's prior and superior rights in and to Opposer's ASTUCCI mark.

15. Applicant's Mark falsely suggests a connection or affiliation with Opposer and Applicant is therefore not entitled to registration of Applicant's Mark.

16. In view of the foregoing, Applicant's Mark, as applied to Applicant's Goods, is confusingly similar to Opposer's ASTUCCI mark as applied to Opposer's Goods and is likely to cause confusion, mistake, or deception amongst the general and consuming public as to whether Applicant's Goods originate with Opposer, or are licensed, authorized or sponsored by Opposer or are promoted with Opposer's approval in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

WHEREFORE, Opposer respectfully requests that the '399 Application be refused, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

Dated: October 28, 2015

By: /David B. Sunshine/
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CERTIFICATE OF SERVICE

I hereby certify that, in accordance with Rule 2.101(b) of the Trademark Rules of Practice, that I have on October 28, 2015, served the foregoing Notice of Opposition on Applicant by causing a true and correct copy thereof to be deposited in the United States Mail, postage prepaid, addressed to the attorney of record for the Applicant as follows:

Jonathan Myers

Lucas & Mercanti, LLP

21st Floor, 30 Broad Street

New York, NY 10004

/David B. Sunshine/

EXHIBIT 1

Int. Cls.: 9 and 18

Prior U.S. Cls.: 1, 2, 3, 21, 22, 23, 26, 36, 38 and 41

United States Patent and Trademark Office

Reg. No. 2,627,183

Registered Oct. 1, 2002

**TRADEMARK
PRINCIPAL REGISTER**

ASTUCCI

ASTUCCI U.S. LTD. (NEW YORK CORPORATION)
385 5TH AVENUE SUITE 1005
NEW YORK, NY 10016

FOR: EYEGLASS CASES, IN CLASS 9 (U.S. CLS. 21,
23, 26, 36 AND 38).

FIRST USE 6-10-1994; IN COMMERCE 8-1-1994.

FOR: HANDBAGS , IN CLASS 18 (U.S. CLS. 1, 2, 3,
22 AND 41).

FIRST USE 6-10-1994; IN COMMERCE 8-1-1994.

SER. NO. 75-909,514, FILED 1-12-2000.

CHERYL CLAYTON, EXAMINING ATTORNEY